

REMARKS/ARGUMENTS

The foregoing amendment reintroduces many of the claims of the present invention in either their original or subsequently amended form. For reasons set forth below, Applicant submits that new independent claims 34 and 52-56 define sundries caddies for furniture which are neither disclosed nor suggested by any individual reference or any combination of the many references of record that have been cited against the claims of the application to date.

New independent Claim 34 is identical to former independent Claim 1 as amended by an amendment submitted on January 20, 2005. That claim was subsequently rejected. More particularly, in an Office Action dated June 2, 2005, Claim 1, *inter alia*, was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,605,235 to Johnson in view of U.S. Patent No. 4,466,148 to Jones. Such rejection was and remains respectfully traversed.

The Johnson device is a sundries caddy for furniture having a first horizontal section 28 that is insertable between a cushioning object and a cushion support structure of a piece of furniture so as to define a captured portion of the caddy when inserted between the furniture cushioning object and cushion support structure. Johnson further includes a second vertical section 26 that defines a free portion of the caddy when the first horizontal section 28 is inserted between the furniture cushioning object and cushion support structure. The second section 26 carries a pocket 12 that is integrally formed

therewith (note Claim 1 of Johnson which describes the device as being monolithic). The pocket 12 projects from the front face of vertical section 26. According to a preferred embodiment it projects one inch from the vertical section 26; see column 4, lines 9-11.

As defined in Applicant's independent Claim 34, the first and second members of the caddy are interchangeably operable as the captured portion and the free portion. That is not the case with the first and second sections 28, 26 of the Johnson device. More particularly, if one were to insert the vertical pocket-carrying section 26 of the Johnson device between a furniture cushioning object and cushion support structure, the device would be rendered inoperative because the pocket 12 would be covered by the furniture cushioning object and because the now "free" portion 28 is not equipped with a pocket. Moreover, if the Johnson device were simply inverted such that vertical section 26 projected upwardly rather than downwardly with respect to horizontal section 28, the device would also be rendered inoperative because the opening of pocket 12 would face downwardly rather than upwardly.

In that Office Action, the Examiner dismissed Applicant's recitations "wherein said first and second members are interchangeably operable as said captured portion and said free portion" and "whereby a user of the caddy can orient said open end of said receptacle upwardly regardless of whether said free portion extends upwardly or downwardly with respect to said captured portion" as mere recitations with respect to the manner in which a claimed apparatus is intended to be employed which

"does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation." Applicant again respectfully disagrees.

Firstly, the cited recitations are more than simply manners in which Applicant's furniture caddy as defined in Claim 34 is intended to be employed. As to the first recitation, it is the structure of Applicant's first and second members as embodied, for example, in FIGS. 6A, 7 and 11A and 11B, that enables those members to be interchangeable as the captured and free portions. As explained above, the pocket-carrying vertical section 26 of the Johnson device must at all times be the free portion and the horizontal section 28 must always be the captured portion of the device. They are not interchangeable with one another. If one attempted to do so, he or she would be left with a useless device -- as well as a furniture cushion, mattress, or the like, with an unsightly and uncomfortable hump created by the raised pocket 12.

Additionally, Claim 34 specifies "means for connecting said receptacle to said free portion whereby a user of the caddy can orient said open end of said receptacle upwardly regardless of whether said free portion extends upwardly or downwardly with respect to said captured portion." This structural limitation is nowhere to be found in the Johnson device. Indeed, as noted above, the open end of the pocket 12 of Johnson would face downwardly if the device were inverted from its illustrated position, thereby destroying the utility of the device.

As for Jones, the Examiner relies upon that reference for the teaching of "a means 16 for connecting a receptacle to said free portion of a device." Based on this teaching, the Examiner maintains that: "It would have been obvious to employ a connecting means as taught by Jones in order to secure the receptacle to the free end of Johnson." Again, Applicant respectfully disagrees.

First, the Johnson device is expressly defined as being "monolithic." Therefore, its pocket 12 is integrally attached to the vertical section 26. Jones discloses a handgun holster 40 that is releasably connected to a vertically adjustable holster support bar 19 via a belt loop 41 (FIG. 4) or an unillustrated clip. To suggest that it would be obvious in light of Jones to detachably connect the pocket 12 of the Johnson device to the vertical section 26 is to ignore or, worse, directly conflict with a fundamental feature of the Johnson device. Applicant submits that it is not lightly to be assumed that one would find it obvious to detachably connect the pocket 12 of the Johnson device based on the conflicting teachings of the Jones reference. Indeed, such an assumption cannot be reconciled by what the Johnson and Jones devices actually teach and would, therefore, be improper.

Second, even if Jones were somehow properly combinable with Johnson -- which it is not -- the Jones reference contains no teaching or suggestion of first and second members that are interchangeably operable as the captured portion and the free portion of the device. To the contrary, the captured portion of the T-shaped bracket 12 of the handgun holster mounting device

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of Jones, like the captured portion 28 of Johnson, must always be the captured portion of the device and the vertical wall "free" portion of the bracket must always be the free portion of the device. They physically are not interchangeable with one another.

Applicant thus respectfully submits that no combination of the teachings of Jones with Johnson -- whether proper or improper -- can produce the sundries caddy specifically recited in Applicant's independent Claim 34. Therefore, any Section 103(a) rejection of that claim and any of its dependent claims made in reliance upon Johnson in combination with Jones would be improper.

New independent Claim 52 is identical to former independent Claim 27 as amended by aforementioned January 20, 2005. That claim also was subsequently rejected. In a July 12, 2005 Office Action, Claim 27 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,186,501 to Eddy. Such rejection is respectfully traversed.

Eddy fails to disclose at least two prominent features of the invention prescribed in new Claim 52, the first of which is common to all of Applicant's claims. Specifically, Eddy is silent as to "means for connecting said receptacle to said free portion whereby a user of the caddy can orient said open end of said receptacle upwardly regardless of whether said free portion extends upwardly or downwardly with respect to said captured portion."

In stark contrast, the free portion 14 of the Eddy device can never extend upwardly with respect to the captured portion 12. Panels 12 and 14 are joined by an integral reduced thickness zone 16 which defines a "living hinge." See Eddy at column 2, lines 24-27. Column 3, lines 9-16 expands upon the structure of "living hinge" 16 (emphasis added):

Other than the short bar 22 and the fasteners 24, the holster 10 is constructed of a single piece of plastic material suitable for forming the "living hinge" along the zone 16. The zones 34 may be defined in the first panel 12 by forming a plurality of grooves in the panel 12 on only one side thereof while the zone 16 may be formed by forming registered grooves in opposite sides of the panel 12.

In view of these passages and the attendant drawing figures of Eddy, it is clear that the free portion 14 of the Eddy device simply cannot extend upwardly with respect to the captured portion 12. A handgun is typically a relatively heavy object. If a handgun were secured to the free portion 14 of Eddy with that portion extending upwardly, the free portion would immediately swing or flop downwardly due to the structural weakness inherently created by the intentionally thinned region of material defining the "living hinge" 16. And, once swung downwardly, the free portion 14 would turn the handgun upside down whereby it could fall from the holster -- a potentially very dangerous situation. In summary, the Eddy patent is silent with regard to any teaching of a user's ability to (1) selectively dispose the device in any position other than that illustrated, or (2) selectively orient a receptacle with respect to the free portion such that its open end always faces upwardly

notwithstanding whether the free portion extends upwardly or downwardly with respect to the captured portion.

Secondly, with due regard, the Examiner has misinterpreted the passage relied upon for a teaching of the extensible segment specified in new claim 52 in two respects. That passage is part of the paragraph bridging columns 2 and 3, which paragraph is reproduced below in its entirety (with emphasis added).

The first panel 12 includes longitudinally spaced transversely extending zones 34 of reduced thickness along which the first panel 12 may be bent, cut or broken in order to shorten the first panel 12 as desired. In addition, each of the areas 36 of the first panel 12 between the zones 34 thereof is provided with a pair of bores 38 through which suitable fasteners may be secured in order to fasten the first panel 12 to a suitable support structure such as the underside 40 of a desk, counter or table in the manner illustrated in FIG. 4 of the drawings. It will be noted from FIG. 4 that the first panel 12 has been foreshortened at the third zone 34 thereof spaced from the zone 16.

It is initially noted that the reduced thickness zones 34 described by Eddy are provided on the captured panel 12 rather than the free panel 14 of the Eddy device. See FIGS. 1 and 3. This is diametrically opposite to that called for in claim 52, i.e., the extensible segment is provided on the free portion, not the captured portion.

Furthermore, the reduced thickness zones 34 are sites at which a user may bend, cut or break the first panel 12 in order to shorten, indeed permanently shorten, that panel. Applicant's claimed extensible segment enables a user to selectively shorten

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and lengthen the free portion of the caddy at any time as conditions may require.

Clearly, the Eddy device falls well short of anticipating or rendering obvious Applicant's independent Claim 52. Accordingly, Applicant submits that any Section 102(b) or Section 103(a) rejection of that claim made in reliance upon Eddy would be improper.

New independent Claim 53 is identical to former independent Claim 28 as amended by aforementioned January 20, 2005. That claim also was subsequently rejected. In the July 12, 2005 Office Action, Claim 28 was also rejected under 35 U.S.C. § 102(b) as being anticipated by Eddy. Such rejection is respectfully traversed.

Claim 53 requires that the first and second members of the presently claimed invention be hingedly connected to one another. Applicant does not dispute that the captured and free panels 12 and 14 of the Eddy device are hingedly connected at "living hinge" 16. However, for reasons set forth above, the free portion 14 of the Eddy device cannot assume an operative position where it extends upwardly with respect to the captured portion 12 -- which is a requirement of all of Applicant's claims. Eddy thus does not disclose or suggest the sundries caddy for furniture defined in Claim 53. As a consequence, any Section 102(b) or Section 103(a) rejection of that claim made in reliance upon Eddy would be improper.

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New independent Claim 54 is identical to former independent Claim 32 as amended by aforementioned January 20, 2005. That claim also was subsequently rejected. In the July 12, 2005 Office Action, Claim 32 was also rejected under 35 U.S.C. § 102(b) as being anticipated by Eddy. Such rejection is respectfully traversed.

Again, the free portion 14 of the Eddy device cannot assume an operative position where it extends upwardly with respect to the captured portion 12. On this basis alone Eddy does not disclose or suggest the sundries caddy for furniture defined in Claim 54.

In addition, Claim 54 also prescribes:

wherein said means for releasably connecting said receptacle to said free portion comprise a pocket attached to said receptacle, said pocket having an open end facing in a direction substantially opposite said open end of said receptacle, said pocket being operable to receive one end of the free portion when the caddy is disposed in a first operative orientation and the opposite end of the free portion when the caddy is disposed in an inverted second operative orientation.

It is first noted that the free portion (panel 14) of Eddy does not have first and second ends that can be received in a pocket of a receptacle as set forth in Claim 54. To the contrary, it has a single distal end near the holster carrying structure (elements 18, 20, 22 and 24) that could theoretically be received within holster loop 28. However, it could only be received in holster loop 28 when the free panel 14 is disposed downwardly with respect to the captured panel 12 since the free

panel 14 cannot be practically disposed upwardly with respect to the captured portion during operation of the Eddy device. And, in such downward disposition of the free panel 14, the handgun and/or holster is apt to slide from the panel, which is not only potentially dangerous as discussed above but also represents a situation where the Eddy device is rendered useless for its intended purpose.

The opposite "end" of panel 14 is the "living hinge" 16. The holster loop cannot engage such an "end" in any way -- which is another unique feature explicitly required by Claim 54.

Eddy thus does not disclose or suggest the sundries caddy for furniture defined in Claim 54. As a consequence, any Section 102(b) or Section 103(a) rejection of that claim made in reliance upon Eddy would be improper.

New independent Claims 55 and 56 correspond identically to former independent Claims 30 and 31 as amended by aforementioned January 20, 2005. Those claims also were subsequently rejected. In the most recent Office Action, Claims 30 and 31 were rejected under 35 U.S.C. § 103(a) as being over Eddy in view of U.S. Patent No. 5,946,432. Such rejection is respectfully traversed.

Again, the free portion 14 of the Eddy device cannot assume an operative position where it extends upwardly with respect to the captured portion 12. On this basis alone Eddy does not disclose or suggest the sundries caddies for furniture defined in Claims 55 and 56. Ennis offers nothing to overcome this

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fundamental deficiency of Eddy vis-à-vis the inventions claimed in Claims 55 and 56.

The Ennis device is a baby bottle holder that uses one elastic band 38 for strapping a first leg 20 holder to a structure such as the handle of a baby carrier, and another elastic band 30 for strapping a baby bottle to a second leg 22 of the holder. The holder further includes handles 24 and 26 on leg 20 that are adapted to be grasped by a baby. Those handles would effectively prevent insertion of either leg 20 or 22 between a cushioning object and a cushion support structure whereby the device could assume relative inverted positions.

Consequently, no combination of Ennis and Eddy can produce the inventions of claims 55 and 56. Therefore, any Section 103(a) rejection of those claims made in reliance upon Eddy and Ennis would be improper.

At this juncture, Applicant respectfully requests that prosecution be brought to a definitive conclusion. For the many reasons presented above, Applicant earnestly believes that many significant structural distinctions patentably set the instant claims apart from the teachings of references of record, whether considered individually or collectively. Accordingly, Applicant kindly urges that the claims of the present application be allowed at this time. Nine patent references in continuously evolving arrangements have been cited against Applicant's claims through the course of five Office Actions. Even if the Examiner continues to disagree with Applicant's position, there is nevertheless some comfort in closure. Recall that there is no

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matter in the newly submitted claims that the Examiner has not already fully considered in light of the references of record. Thus, if the Examiner still cannot bring himself to allow all of the application's claims at this time, Applicant kindly requests that the next Office Action be made final so that the application may proceed to appeal.

If the Examiner believes that a telephone interview would be beneficial to advance prosecution of the present application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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